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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,503	08/05/1999	LARREN F. JONES	51291.81516	5616

22907 7590 04/19/2005

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WASHINGTON, DC 20001

EXAMINER
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BATSON, VICTOR D

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/368,503

Applicant(s)

JONES ET AL

Examiner

Victor Batson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-138 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-138 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/6/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Defective Oath/Declaration***

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The specific changes/amendments to the claims must also be identified in the declaration, in addition to the errors in the original claims.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-138 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 119-124, 135-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5,088,214) in view of Jones et al. (4,433,496).

Jones '214 discloses a wear assembly having all of applicant's claimed structure including a boss 29, a wear member including a longitudinal slot, and a lock 38. Jones '214 however lacks the lock including an adjustment assembly movable to tighten the mounting of the wear member on the lip.

Jones et al. '496 teaches that it is known in the art to use a lock including an adjustment assembly movable to tighten the fit of the lock and eliminate looseness in the wear assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the wear assembly of Jones (5,088,214) by using a lock with an adjustment assembly as taught by Jones et al. '496, to eliminate looseness in the wear assembly.

### ***Response to Arguments***

Applicant's arguments filed 12/6/04 have been fully considered. Applicant's note regarding the new reissue declaration has been noted, however the rejection has been maintained for consistency and clarity. Applicant's discussion of the prior art (pages 5-7) has been noted. Applicant's arguments regarding claim 119 are not persuasive. Applicant argues that one of ordinary skill in the art would not have considered it obvious to have provided the '214 patent with an adjustable lock as shown in the '496 patent because the '214 patent was intended to be of a simple construction and seeks to avoid the kind of complex lock in the '496 patent. Although the Jones '214 patent

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describes the assembly as providing an advantageous lateral stabilization but without the need for extensive locks or secondary surfaces, the examiner does not agree that an "extensive lock" is necessarily a "complex lock" similar to the lock in the '496 patent.

Applicant argues that the wear assembly in the '214 patent is designed with the expectation that the wear member will shift during use, and therefore, there is no recognized need in the '214 patent for the use of a complex lock to tighten the assembly and thereby prevent movement of the wear member. Although Jones '214 anticipates movement of the wear member, this is anticipated to occur during "wear in". It is the examiner's position that adjustable locks similar to the '496 lock would be beneficial to reduce excessive movement of the assemblies after extensive wear in and therefore combination would have been obvious to one of ordinary skill in the art.

In response to applicant's argument that the '496 patent only suggests the use of a lock that fits into a through-hole formed in the lip (page 8), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding claim 135, applicant argues that the wear member is not formed to abut against the front wall of the boss, and that even if some contact occurs during loading between the front wall and the boss, this contact would not be face-to-face contact as claimed. The examiner disagrees and notes that although the upper inclined

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surface of boss 29 is spaced from the wear member, in figure 2, Jones '214 shows the front wall of the boss positioned immediately adjacent a rearwardly facing bearing surface. Clearly after "wear in" the surfaces would be abutting, with the boss inherently resisting rearwardly directed loading during use. Additionally, Jones '214 in column 5 lines 25-27 specifically describes the wear member encountering the boss.

The examiner notes that although further amending of the adjustment member in claim 119, and amending the rearwardly facing bear surface of claim 135 was discussed in a previous interview, it is the examiner's position that the current amendments did not include enough structure to define over the prior art of record.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (703) 305-6356. The examiner can normally be reached on Monday through Friday (except Wednesday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (703) 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 14, 2005



Victor Batson  
Primary Examiner  
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